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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/818,644 | 03/28/2001 | Naonori Kato | 33216M072 | 2473 |

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| EXAMINER | |
|---|---|
| STRANGE, AARON N | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2153 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/818,644 | KATO ET AL. | |
| | Examiner | Art Unit | |
| | Aaron Strange | 2153 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3 and 5-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1. It is noted that Applicant asserts that amended versions of Figures 2 and 3 were filed in response to the last Office action. However, the Examiner has not received the amended figures and accompanying letter. Resubmission of the documents is requested in response to this Office action.

### *Priority*

2. It is noted that Applicant asserts that a certified copy of priority document 2000-097,136 was filed in response to the last Office action. However, the Examiner has not received the certified copy. Resubmission of the required document is requested in response to this Office action.

### *Response to Arguments*

3. Applicant's arguments filed 11/12/2004 have been fully considered but they are not persuasive.

4. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant merely alleges that "Neither Edson nor Daniels teaches or fairly

suggests a gateway apparatus that includes the identification information storing means and the identification information described in claim 1", without pointing out how the language of the claims distinguishes them from the references.

5. With regard to claim 1, and Applicant's assertion that "Neither Edson nor Daniels teaches or fairly suggests a gateway apparatus that includes the identification information storing means and the identification information described in claim 1", it is noted that the claimed identification information is not described in the specification. . The section cited by Applicant in alleged support for this amendment (Fig 18) shows only a table correlating commands for a device with the appropriate control code.

While the added limitations are not supported by the specification, the Examiner agrees that the combination of Edson and Daniels fails to teach storing identification information what "identifies each said apparatus and identifies functions performable by each said apparatus together with a description of each function". However, upon further consideration, a new ground(s) of rejection is made below.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. With regard to claim 1, the limitation "said identification identifies each said apparatus and identifies functions performable by each said apparatus together with a description of each function" is not described in the specification. The section cited by Applicant in alleged support for this amendment (Fig 18) shows only a table correlating commands for a device with the appropriate control code. Upon receiving a control code, a device will perform the associated action. Further clarification of Figure 18 can be found in the specification at Page 20, Lines 13-22.

While Figure 18 and Page 20, lines 13-22 of the present application appear to show a list of functions performable by an apparatus, they do not show or even suggest that the identification information stored by the present invention identifies each said apparatus together with a description of each function. Figure 18 and Page 20, Lines 13-22 merely show and describe a table containing a correlation between actions performable by an apparatus and the appropriate control code to send to the apparatus in order to cause it to perform that function.

9. Claims 2,3, and 5-7 are rejected for the same reasons as claim 1, since they depend from claim 1. Claim 8 is rejected for the same reasons as claim 1, since it includes the exact same limitation in lines 16-18.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (US 6,526,581) in view of Zintel et al. (US 2002/0035621).

12. With regard to claims 1 and 8, Edson discloses a gateway apparatus (Fig 1, 13) connected to a first network (Fig 1, 15,17, or 19) and a second network (Fig 1, 23 or 21) and for controlling the operation of an apparatus or a plurality of apparatuses (Fig 1, 31,32,33,34, 41, or 42) of control objective connected to said first network depending on instructions directed to said second network (Col 15, Lines 40-44) by an instructing apparatus (Fig 1, 43) connected to said first network for said apparatus or plurality of apparatuses of control objective, the gateway apparatus comprising:

monitoring means monitoring a flow of the instructions, for controlling the operation of said apparatus or plurality of apparatuses of control objective, directed to said network by said instructing apparatus (gateway must monitor instructions to forward them to the appropriate devices) (Col 15, Lines 29-39);

control signal outputting means of outputting a control signal for controlling the

operation of said apparatuses of control objective depending on the instructions received when said flow of the instructions is monitored by said monitoring means; (control codes are received by devices)(Col 7, Lines 44-47); and

identification information storing means for storing the identification information of each of said apparatuses of control objective (New devices are identified and configured) (Col 11, 9-19).

While Edson fails to specifically recite that said control signal is outputs using stored identification information, this limitations are inherent. Edson discloses that commands for controlling the devices are sent by the instructing apparatus (PC) to the gateway (Col 7, Lines 51-54), and that the commands are received by the devices to be controlled (Col 7, Lines 45-47). Therefore, the control signal outputting means must use the identification means in order to determine which device should receive the control signal. Therefore, these elements are present in the system disclosed by Edson, despite the lack of a specific reference to them. However, Edson fails to disclose that the stored identification information identifies each said apparatus and identified functions performable by each said apparatus together with a description of each function.

Zintel teaches receiving and storing identification information identifying a device, functions performable by that device, and a description of each function (Par 13). The information is collected from the device when it is introduced to the network. This allows other devices to obtain information about the device and how to interact with it. This would have been an advantageous addition to the system disclosed by Edson since it

would have provided the gateway and/or user with information about each device on the network and the functions is could perform, so interaction could occur with the newly connected device.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the system disclosed by Edson to store identification information identifying a device, functions performable by that device, and a description of each function since it would have provided the gateway and/or user with information about each device on the network and the functions is could perform, so interaction could occur with the newly connected device.

13. With regard to claim 2, Edson further discloses control information setting means in which control information for controlling the operation of said apparatuses of control objective is set (Control information is set in gateway using PC) (Col 7, Lines 51-54), wherein said control signal outputting means outputs said control signal by using said control information set in said control information setting means (Parameters are referenced for control, such as user's desired temperature) (Col 15, Lines 33-39).

14. With regard to claim 3, Edson further discloses that said control information is set in said control information setting means by an access from said instructing apparatus (PC is used to change settings) (Col 7, Lines 51-54), by a user 's input operation (User changes setting via PC) (Col 7, Lines 51-54), or by an access from said apparatuses of control objective (Devices report their current status so desired changes can be

determined) (Col 7, Lines 45-47).

15. With regard to claim 5, Edson further discloses that said identification information is stored in said identification information storing means by an access from said instructing apparatus, by a user's input operation, or by an access from said apparatuses of control objective (New devices identify themselves to the gateway) (Col 11, 9-19).

16. With regard to claim 6, Edson further discloses device identification information acquiring means of acquiring said identification information of each of said apparatuses of control objective from all or a part of said apparatuses of control objective, wherein said identification information storing means stores said identification information obtained by said device identification information acquiring means (New devices are automatically identified and configured by the gateway) (Col 11, Lines 9-19).

17. With regard to claim 7, Edson further discloses data converting means of converting the data from said second network into data available for said instructing apparatus (interface cards convert between protocols for different networks) (Col 10, Lines 55-59).

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
3/22/2005

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